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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

LAM, ANDREW H

ART UNIT	PAPER NUMBER
2625	

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/989,340	Applicant(s) PARRY, TRAVIS J.	
	Examiner Andrew H. Lam	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 08/17/06.
- Claims 1-17 and 19-21 are pending in the present application. Claims 1, 11 and 16 are amended.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Czyszczewski et al. (U.S. Patent No. 6,577,907) hereinafter Czyszczewski in view of Chang et al. (U.S. Pub. No. 2002/0055984) hereinafter Chang.

Regarding claims 1 and 21, Czyszczewski discloses a method of distributing (col. 7, lines 22-25) print job data from an e-mail enable printer (fig. 1, MFP device 10, capable of sending or receiving email with attachment for printing), said print job data to be printed by the e-mail enabled printer (col. 3, lines 1-5) said e-mail enabled printer capable of creating and sending e-mails, said method comprising: retrieving said print job data from a memory of said e-mail enable printer (col. 3, lines 30-32); attaching said print job data to an e-mail (col. 3, lines 30-32, see fig. 9D) created by said e-mail enabled printer; sending said e-mail and said print job data from said e-mail enabled printer to an e-mail enable device (col. 1, lines 50-51, send and receive email and col. 3,

lines 5-7, redirect to another printer or output device and see fig. 3, multiple MFP that can send and receive email with attachment); and storing said print job data in a job retention memory of said e-mail enabled device (col. 3, lines 5-6, hold for later access).

Czyszczewski does not disclose expressly a printer and the recited elements that are part of the printer i.e. inside the printer (see fig. 1, multifunction controller with user interface 25).

Chang discloses in figs. 4a to 4c that printer controller can be reside inside the printer as shown in fig. 4c.

Czyszczewski and Chang are combinable because they are from a similar field of endeavor of communication and exchange of information between devices such as e-mail. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the integration of the printer controller unit as taught by Chang with the printers (fig. 1, 43) of Czyszczewski. The motivation for doing so would have been to reduce the cost of material when compared to implementing separate controllers (col. 10, paragraphs 118-121, see fig. 4c in Chang).

Regarding claim 2, the combination (Czyszczewski) discloses the method of claim 1, wherein said retrieving said print job data from said memory of said e-mail enabled printer comprises retrieving said print job data from a job retention memory of said e-mail enabled printer (col. 3, lines 5-7, hold a document for later access, also col. 3, lines 10-40).

Regarding claim 3, the combination (Czyszczewski) discloses the method of claim 1, wherein said retrieving said print job data from a memory of said e-mail enabled

printer is initiated using a device in communication with said e-mail enabled printer (col. 3, lines 10-30, database record, and col. 6, lines 50-60, see fig. 4).

Regarding claim 4, the combination (Czyszczewski) discloses the method of claim 3, wherein said device in communication with said e-mail enabled printer includes a network device selected from a group consisting of a workstation, an e-mail enabled printer, and an e-mail server (see fig. 4, email server 75).

Regarding claim 5, the combination (Czyszczewski) discloses the method of claim 1, further comprising creating an e-mail for attaching said print job data to, said e-mail including an e-mail address (inherent that email needs an address to send the email and attachment to, see fig. 9E, enter email address or name of people to send email to).

Regarding claim 6, the combination (Czyszczewski) discloses the method of claim 5, wherein said creating an e-mail for attaching said print job data to comprises: providing a list of available e-mail addresses; selecting at least one of said available e-mail addresses; and creating an e-mail addressed to each of said selected at least one available e-mail addresses (col. 12, lines 60-67 and col. 13, lines 1-9, see fig. 9D).

Regarding claim 7, the combination (Czyszczewski) discloses the method of claim 6, wherein said providing a list of available e-mail addresses comprises: retrieving a list of stored e-mail addresses from a memory of said e-mail enabled printer; and displaying said list of stored e-mail addresses for selection (col. 13, lines 1-9, see fig. 9D).

Regarding claim 8, the combination (Czyszczewski) discloses the method of claim 5, wherein said creating an e-mail for attaching said print job data to comprises: retrieving at least one e-mail address entered by a user; and creating an e-mail addressed to said at least one e-mail address entered by said user (col. 12, lines 60-67, see fig. 9D).

Regarding claim 9, the combination (Czyszczewski) discloses the method of claim 1, wherein said attaching said print job data to an e-mail created by said e-mail enabled printer comprises attaching said print job data to an e-mail addressed to at least one designated e-mail address (col. 13, lines 5-9, see fig. 9D, attachment can be text or PDF).

Regarding claim 10, the combination (Czyszczewski) discloses the method of claim 1, wherein said sending said e-mail and said print job data to an e-mail enabled device comprises sending an e-mail and said print job data from said e-mail enabled printer to a network device selected from the group consisting of a workstation, an e-mail enabled printer, and an e-mail server (see fig. 3 and 4).

Regarding claim 11, Czyszczeowski discloses a method of distributing (col. 7, lines 22-25) a print job (fig. 1, MFP device 10, capable of sending or receiving email with attachment for printing), comprising: storing one or more print jobs in a memory of an e-mail enabled printer (col. 3, lines 5-7, hold a document for later process), each of said print jobs comprising data to be printed by the e-mail enable printer (col. 3, lines 1-5); selecting at least one of said print jobs stored in said memory of said e-mail enabled printer for distribution (col. 3, lines 30-32, see fig. 9D); creating an e-mail (fig. 9D and

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9E); attaching said data of selected at least one print job to said e-mail (col. 3, lines 30-32, see fig. 9D, document attached as PDF or text); and sending said e-mail for distributing said data of said selected at least one print job (col. 1, lines 50-52, sending and receiving data such as e-mail via MFP device 10, i.e., the device 10 is networked such as fig. 3 and each MFP devices can send and receive email or fax).

Czyszczewski does not disclose expressly a printer and the recited elements that are part of the printer i.e. inside the printer (see fig. 1, multifunction controller with user interface 25).

Chang discloses in figs. 4a to 4c that printer controller can be reside inside the printer as shown in fig. 4c.

Czyszczewski and Chang are combinable because they are from a similar field of endeavor of communication and exchange of information between devices such as e-mail. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the integration of the printer controller unit as taught by Chang with the printers (fig. 1, 43) of Czyszczewski. The motivation for doing so would have been to reduce the cost of material when compared to implementing separate controllers (col. 10, paragraphs 118-121, see fig. 4c in Chang).

Regarding claim 12, the combination (Czyszczewski) discloses the method of claim 11, wherein storing one or more print jobs in said memory of said e-mail enable printer comprises: sending a print job to an e-mail enabled printer (col. 1, lines 50-53 and col. 3, lines 1-5, also, see fig. 3); receiving said sent print job at said e-mail printer

(col. 1, lines 50-53); and storing said print job in a job retention memory of said e-mail enabled printer (col. 3, lines 5-7).

Regarding claim 13, the combination (Czyszczewski) discloses the method of claim 11, wherein said creating an e-mail comprises (see. figs. 9D and 9E): retrieving a list of available e-mail addresses from said memory of said e-mail enabled printer (col. 13, lines 1-9); selecting at least one e-mail address from said retrieved list of available e-mail addresses (col. 13, lines 1-9); and addressing an e-mail with said selected at least one e-mail address (col. 13, lines 1-9).

Regarding claim 14, the combination (Czyszczewski) discloses the method of claim 11, wherein said creating an e-mail comprises (see figs. 9D and 9E): entering at least one e-mail address into said e-mail enabled printer using a control panel of said e-mail enabled printer (see figs. 9D and 9E); and addressing an e-mail with said at least one entered e-mail address (col. 12, lines 60-67).

Regarding claim 15, the combination (Czyszczewski) discloses the method of claim 11, wherein said selecting at least one of said print jobs stored in said memory of said e-mail enabled printer for distribution comprises (see figs. 9D and 9E): retrieving a list of print jobs stored in said memory of said e-mail enabled printer from said memory (col. 3, lines 5-10); displaying said list of print jobs stored in said memory (fig. 9E, col. 3, lines 5-7, document is hold for later access--it is implicit that when a document is stored or hold for later access therefore the user using the interface of fig. 9E can display a listing of the document for selection); providing a control panel (fig. 9E, user interface) for selecting at least one of said print jobs in said list of print jobs; and selecting at least

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one of said print jobs using said control panel (fig. 9E, user interface, col. 12, lines 1-65).

Regarding claim 16, Czyszczewski discloses a system for distributing (col. 7, lines 22-25) a print job, comprising (see fig. 3): a network (fig. 3, global network 50); and at least one e-mail enabled printer for communicating over said network (fig. 3, 25A and 135A), said e-mail enabled printer comprising at least one microprocessor for operating said e-mail enabled printer (fig. 2, cpu 80), including translating data of said print job into an image format for printing by said e-mail enabled printer and attaching said data of said print job to an e-mail (fig. 9D and 9E, col. 13, lines 5-8); a display device for displaying said print job (fig. 9D and 9E), and a job retention memory (col. 3, lines 5-7) for storing said data of said print job for distribution.

Czyszczewski does not disclose expressly a printer and the recited elements that are part of the printer i.e. inside the printer (see fig. 1, multifunction controller with user interface 25).

Chang discloses in figs. 4a to 4c that printer controller can be reside inside the printer as shown in fig. 4c.

Czyszczewski and Chang are combinable because they are from a similar field of endeavor of communication and exchange of information between devices such as e-mail. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the integration of the printer controller unit as taught by Chang with the printers (fig. 1, 43) of Czyszczewski. The motivation for doing so would have

been to reduce the cost of material when compared to implementing separate controllers (col. 10, paragraphs 118-121, see fig. 4c in Chang).

Regarding claim 17, the combination (Czyszczewski) discloses the system of claim 16, wherein said e-mail enabled printer further comprises a control panel for selecting said print job from one or more print jobs displayed on the display device (fig. 9E, col. 3, lines 5-7, document is held for later access--it is implicit that when a document is stored or held for later access therefore the user using the interface of fig. 9E can display a listing of the document for selection).

Regarding claim 19, the combination (Czyszczewski) discloses the system of claim 16, wherein said e-mail enabled printer further comprises at least one list of e-mail addresses for displaying on said display device (col. 12, lines 10-15).

Regarding claim 20, the combination (Czyszczewski) discloses the system of claim 16, further comprising: an Internet connection for communicating with said network (col. 3, lines 19-20); an e-mail server for communicating with said network (fig. 4, email server 75); and at least one workstation for communication with said network (fig. 4, A, B and C databases can be interpreted as a workstation).

Response to Arguments

Applicant's arguments, see pages 6-7, filed 08/17/06, with respect to the rejection(s) of claims 1-17 and 20-21 under 102(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art references due to newly amended limitations as cited in claims 1, 11 and 16.

Contact Information

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew H. Lam whose telephone number is (571) 272-8569. The examiner can normally be reached on M-F (9:30-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andrew Lam 10/26/06

KAW Williams
KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER